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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,830	07/17/2003	John J. Hahn	650770.90112	1990

26710 7590 03/27/2007  
QUARLES & BRADY LLP  
411 E. WISCONSIN AVENUE  
SUITE 2040  
MILWAUKEE, WI 53202-4497

EXAMINER
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ELOSHWAY, NIKI MARINA

ART UNIT	PAPER NUMBER
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3781

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/27/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/621,830

Applicant(s)

HAHN ET AL.

Examiner

Niki M. Eloshway

Art Unit

3781

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 31-57 is/are pending in the application.
- 4a) Of the above claim(s) 31-45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 46-57 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |  |
|--|--|
| <p>1) <input type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br/>Paper No(s)/Mail Date _____</p> | <p>4) <input type="checkbox"/> Interview Summary (PTO-413)<br/>Paper No(s)/Mail Date. _____</p> <p>5) <input type="checkbox"/> Notice of Informal Patent Application</p> <p>6) <input checked="" type="checkbox"/> Other: <u>See Continuation Sheet</u>.</p> |
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## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submissions filed on July 10, 2006 and January 3, 2007 have been entered.

### *Response to Amendment*

2. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Claims 1-30 were cancelled in the amendment filed July 10, 2006. 37 CFR 1.121(b)(4) states "A claim which was previously canceled may be reinstated only by adding the claim as a 'new' claim with a new claim number." Claims 18-25, and 27-30 must be renumbered. In addition, claims 31-45 submitted in the response filed July 10, 2006 have not been officially cancelled and therefore remain pending in the application.

The status of the claims is as follows:

(a) Claims 1-17 and 26 have been cancelled.

(b) Misnumbered claim 18-25, and 27-30 have been renumbered as "new" claims 46-57.

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(c) Method claims 31-45 are withdrawn from consideration as set forth in paragraph (6) of the Election-Restriction section below.

**\*\*Attached to this action is a marked up copy of the claims showing the correct status and claim numbers.\*\***

### ***Election/Restrictions***

3. Applicant's election without traverse of the product in the reply filed on August 22, 2005 is acknowledged.

4. Newly added claims 31-45 are directed to an invention that is independent or distinct from the invention originally elected, in the response filed August 22, 2005, for the following reasons: The inventions are distinct if either or both of the following can be shown (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process. For example, the ribs may be molded by a second die part and a third die part would not be used, or the ribs may be welded to the skirt after removing the cap shell from the first and second die parts.

5. Because these inventions are distinct for the reasons given above and the search required for the product is not required for the process, restriction for examination purposes as indicated is proper.

6. Since applicant has received an action on the merits for the originally elected invention, claims 31-45 are withdrawn from consideration as being directed to a non-elected invention. MPEP § 821.02.

### ***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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8. Claim 54 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 54 is dependent on cancelled claim 1. Since the metes and bounds of the claims cannot be ascertained, the claim cannot be further treated on the merits at this time.

*Claim Rejections - 35 USC § 103*

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 46, 47, 50-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson (U.S. 4,627,548) in view of Baar (U.S. 2,394,135). Thompson teaches a grip cap having a cap shell 12 and a grip layer 21. The pad on the top wall is disclosed in col. 3 lines 20-23. Thompson does not teach the plurality of ribs. Baar teaches that it is known to provide a grip layer with ribs. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the grip cap of Thompson with the spaced ribs of Baar, in order to make opening and closing the cap easier.

11. Claims 46-53 and 55-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walding (EP 1,065,149) in view of Baar (U.S. 2,394,135). Walding teaches a grip cap having a cap shell 10 and a grip layer at 42. The pad on the top wall is the portion of element 42 which extends over the top wall. The lower rim is considered to be the lower rim of element 17 and element 41 is the gasket portion. Walding does not teach a plurality of ribs. Baar teaches that it is known to provide a grip layer with ribs. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the grip cap of Walding with the ribs of Baar, in order to make opening and closing the cap easier.

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*Response to Arguments*

12. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection and/or explanations provided therewith.

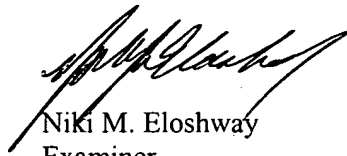
*Conclusion*

13. **THIS ACTION IS MADE NON-FINAL.**

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Niki M. Eloshway whose telephone number is 571-272-4538. The examiner can normally be reached on Thursdays and Fridays 8 a.m. to 4 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Stashick can be reached on 571-272-4561. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Niki M. Eloshway  
Examiner  
Art Unit 3781

nme

Continuation of Attachment(s) 6). Other: marked up copy of pending claims.